



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/123,430	07/28/98	YATES	M4065.073/PD

MM21/0317  
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EXAMINER  
GUERRERO, M

ART UNIT  
2822

PAPER NUMBER

DATE MAILED: 03/17/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
**09/123,430**

Applicant(s)

Yates

Examiner

**Hung Duong**

Group Art Unit

**2822**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-47 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-47 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Restriction Requirement

Claims 1 to 47 are pending in this application.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 28 – 43, and 45-47, drawn to a semiconductor device, classified in Class 257, subclass 9.

II. Claims 1 - 27, and 44 drawn to a process of making a semiconductor device apparatus, classified in Class 438, subclass 747.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, unpatentability of the group I invention would not necessarily imply unpatentability of the method of the group II invention, since the device of the group I invention could be made by processes materially different than that of the group II invention, for example, in claim 1, occasionally removing the upper portion of the semiconductor processing fluid present in the bath. Note specifically in *re Thorpe et al.* as detailed below:

Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In *re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

Because these inventions are distinct for the reasons given above and, as shown by the above different classifications, the fields of search are not co-extensive and separate examination would be required, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Restriction Requirement

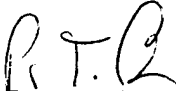
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

***Papers related to this application may be submitted directly to Art Unit 2822 by facsimile transmission. Papers should be faxed to Art Unit 2822 via the Technology Center 2800 Fax Center located in Crystal Plaza 4, room 4 - C23. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Technology Center 2800 Fax Center numbers are (703) 308-7722 and (703) 308-7724. The Technology Center 2800 Fax Center is to be used only for papers related to Technology Center 2800 applications.***

Any inquiry concerning this communication or any earlier communication from the Examiner should be directed to Art Unit 2822's Supervisory Patent Examiner **Peter Toby Brown** whose telephone number is **(703) 308-4083**. The Examiner is in the Office generally between the hours of 6:45 AM to 4:00 PM (Eastern Standard Time) Monday through Friday.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Technology Center 2800 Receptionist** whose telephone number is **(703) 308-0956**.

PTB  
03/16/99

  
Peter Toby Brown  
Supervisory Patent Examiner  
Art Unit 2822